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09/319,093 08/16/99 HAN

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EXAMINER

TM02/0810

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ART UNIT

PAPER NUMBER

2161  
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/319,093**

Applicant(s)

Han

Examiner  
**Huyng S. Soug**

Art Unit  
**2161**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 2161

1. Preliminary amendment filed on January 24, 2001 has been entered except for the following unclear portions:

- Page 2, line 1, "same line, delete "a"".

Line 8, "line 8, change "into" to --into--".

- Page 3, line 5, "line 20, delete "an"".

Line 7, "same line, delete "a"".

### *Drawings*

2. The drawings are objected to by the Examiner for the following reasons:

- They are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the operating unit and the data storage unit (see claims 8 and 38) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

**Applicant is advised to carefully review all the drawings for further needed corrections.**

3. **A proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.**

Art Unit: 2161

*Specification*

4. The disclosure is objected to because of the following informalities:

- Page 16, line 9, should "the payment imposing unit 40" be --the payment imposing unit 50--?
- Page 19, line 9, should "RAM" be --ROM--? See page 18, line 11.
- The following reference sign(s) not mentioned in the description: "S13", "S14", and "S15" (see FIG. 4).

**Applicant is advised to carefully review the entire specification for further needed corrections.**

*Claim Rejections - 35 U.S.C. § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5-7, 18, and 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5, line 2, "it" is not clear. Applicant is suggested to change "when it is judged that the key data received is authentic" to --when the key data received is authenticated--.

Claim 6, line 5 and claim 7, line 5, it is not clear what is referred by "it".

Art Unit: 2161

- Claim 18, line 4 and claim 23, line 6, "corresponding data" cannot be clearly understood. More specifically, it is not clear that "corresponding data" is corresponding to what?
- Claim 41, line 30, "the data indicative of completion of imposing payment" does not have proper antecedent basis.
- Claim 42, line 4, the language "the key data received is authentic" is not clear. More specifically, it is not clear which element receives "the key data".

Line 6, "the data" is not clear. Applicant is advised to insert --read out from the first recording medium-- after "data" to obviate the rejection.

- Claim 44, line 4, "the data" is not clear. Applicant is advised to insert --read out from the first recording medium-- after "data" to obviate the rejection. Further, applicant's attention is directed to the fact that claim 44 does not add any further steps to the base claim 14.

**Applicant is advised to carefully review all the claims for further needed corrections.**

***Claim Rejections - 35 U.S.C. § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2161

8. Claims 1-10, 19-22, and 31- 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani (US PAT. 5,481,411) in view of Ball et al. (Ball hereinafter: EPO 0 309 298).

Nakatani discloses a record/playback apparatus comprising:

a record/playback unit (Figs. 1, 5, 6, and 7) for reading out data from a first recording medium (e.g., master tapes) and recording the data onto a second recording medium (e.g., video, audio or computer soft ware tapes); and

a control unit (elements 6, 35, 70, 80, and 105) for controlling the record/playback unit.

**Re claims 1, 19, 31:** Nakatani does not explicitly disclose that (a) the control unit is for generating basic data for imposing payment from at least data indicative of a user identification and data indicative of a speed for recording the data read out from the first recording medium onto the second recording medium and transmitting the basic data, and when receiving data indicative of the completion of imposing payment, directing the record/playback unit in response to the received data indicative of the completion of imposing payment to start the recording of the data read out from the first recording medium onto the second recording medium and (b) a payment imposing unit for, when receiving the basic data from the control unit, imposing payment according to the received basic data and transmitting to the control unit data indicative of completion of imposing payment. However, Ball discloses the use of royalty encoding and accounting means (page 5, line 2) to insure the calculation and making of the appropriate royalty payments for the copying by the apparatus.

Art Unit: 2161

Further, Ball discloses encoding the royalty information together with information identifying the machine, date, time, and the customer. Thus, it would have been within the level of ordinary skill in the art to modify the apparatus of Nakatani by adopting the teachings of Ball (i.e., using royalty encoding means and accounting means) to insure the calculation and making of the appropriate royalty payments for the copying by the apparatus. It is arguable that Ball does not explicitly disclose the royalty encoding means being located in the control unit. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the royalty encoding means at any desirable location including in the control unit as claimed, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Further, it is arguable that Ball does not use data indicative of a speed for recording the data read out. However, it is well known in the art to employ any relevant data (e.g., length of time for recording the music, different performers for the music, recording speed, different types of recording medium, and etc.) to impose payment to increase profit in business and it would have been common sense to employ any one of those data including data indicative of a speed for recording the data read out as claimed to increase the profit for the claimed apparatus.

**Re claims 2 and 32:** Neither Nakatani nor Ball explicitly discloses the use of a key data generator for the payment imposing unit. However, Ball discloses the use of a communication link (page 5, lines 10) for automatic forwarding of the royalty fees involved in the operation of the apparatus. Thus, it would have been obvious to one of ordinary skill in the art to employ a

Art Unit: 2161

key data generator for the payment imposing unit (i.e., accounting means) to generate key data for secure transmission of the completion of imposing payment over the communication link to the apparatus.

**Re claims 3, 4, 33, and 34:** It is fundamental in the art to verify the key data transmitted through the communication link by collating with key data held by the apparatus to prevent fraud. Further, Ball discloses recording of the data onto the second recording medium based on the judging to discourage subsequent unauthorized copying from the dispensed tapes.

**Re claims 5 and 35:** It is fundamental in the art to transfer any information after authentication of the key to prevent fraud.

**Re claims 6, 7, 36, and 37:** Neither Nakatani nor Ball explicitly discloses the various payment imposing method. However, there are various ways of calculating royalty fees and it would have been within the level of ordinary skill in the art to employ various fee calculating schemes including the claimed schemes as desired.

**Re claims 8 and 38:** Nakatani in view of Ball further discloses an operating unit (i.e., royalty encoding means) connected to the control unit and a data storage unit (i.e., master tapes) where a plurality of data is stored, wherein the control unit reads out corresponding data from the data storage unit in response to indicator data supplied from the operating unit and directs the record/playback unit to record the data read out from the data storage unit onto the first recording medium.



Art Unit: 2161

**Re claims 9, 10, 39, and 40:** Ball discloses various embodiments including the data storage unit and the payment imposing unit are connected via a communications line to the control unit (page 5, lines 10-23). Thus, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Nakatani by adopting the teaching of Ball to enhance the function of the claimed apparatus.

**Re claims 20-22:** Neither Nakatani nor Ball explicitly discloses that the control unit judges key data received as the data indicative of completion of imposing payment is authentic or not by collating with key data held by the control unit. However, Ball discloses the use of a communication link (page 5, lines 10) for automatic forwarding of the royalty fees involved in the operation of the apparatus. Thus, it would have been obvious to one of ordinary skill in the art to generate key data for secure transmission of the completion of imposing payment over the communication link to the apparatus. Further, it is fundamental in the art to verify the key data transmitted through the communication link by collating with key data held by the control unit to prevent fraud.

9. Claims 11-18, 23-30, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball.

Page 2, lines 6-10 and page 3 lines 35-37 thereof, Ball discloses a record/playback method of reading out data from a first recording medium and recording the data onto a second recording medium with the use of an apparatus capable of reading out the data from the first recording

Art Unit: 2161

medium and recording the data onto the second recording medium, the method comprising the steps of:

reading out corresponding data from a data storage unit where a plurality of data is stored and recording the data onto a second recording medium in response to indicator data received from an operating unit in an apparatus for reading out data from a first recording medium and recording the data onto a second recording medium (page 2, lines 6-10);

generating basic data for imposing payment from data indicative of a user identification (i.e., based on input identification, basic data should be generated to calculate an appropriate royalty);

transmitting the basic data from the apparatus to a payment imposing unit (i.e., after generating the basic data based on input identification, the basic data should be transferred to a payment imposing unit (i.e., accounting means) to calculate the appropriate royalty);

imposing payment according to the basic data received and generating data indicative of completion of imposing payment in the payment imposing unit (i.e., after calculating the appropriate royalty, the machine will require payment of the royalty);

transmitting the data indicative of the completion of imposing payment from the payment imposing unit to the apparatus (i.e., after the royalty is paid by a user, the data of the completion of payment should be transferred to the apparatus); and

directing the apparatus to start recording the data read out from the first recording medium onto the second recording medium in response to the data indicative of the completion

Art Unit: 2161

of imposing payment (i.e., after receiving the data of the completion of payment from the payment imposing unit (i.e., accounting means), the apparatus would make a copy of selected music).

**Re claims 11, 23, and 41:** Ball does not explicitly disclose the use of data indicative of a speed for recording the data read out from the first recording medium onto the second recording medium to generate the basic data. However, it is well known in the art to employ any relevant data (e.g., length of time for recording the music, different performers for the music, recording speed, different types of recording medium, and etc.) to impose payment to increase profit in business and it would have been common sense to employ any one of those data including data indicative of a speed for recording the data read out as claimed to generate the basic data to increase the profit for the claimed method.

**Re claims 12 and 25:** Ball does not explicitly disclose the step of generating key data using the payment imposing unit as the data indicative of the completion of imposing payment from the basic data received. However, Ball discloses the use of a communication link (page 5, lines 10) for automatic forwarding of the royalty fees involved in the operation of the apparatus. Thus, it would have been obvious to one of ordinary skill in the art to generate key data for secure transmission of the completion of imposing payment over the communication link to the apparatus.

Art Unit: 2161

**Re claims 13, 14, 26, 27, 42, 43, and 44:** It is fundamental in the art to verify the key data transmitted through the communication link by collating with key data held by the apparatus to prevent fraud. Further, Ball discloses recording of the data onto the second recording medium based on the judging to discourage subsequent unauthorized copying from the dispensed tapes.

**Re claims 15 and 28:** It is fundamental in the art to transfer any information after authentication of the key to prevent fraud.

**Re claims 16, 17, 24, 29, and 30:** Ball does not explicitly disclose the various payment imposing method. However, there are various ways of calculating royalty fees and it would have been within the level of ordinary skill in the art to employ various fee calculating schemes including the claimed schemes as desired.

**Re claim 18:** Ball discloses reading out corresponding data from a data storage unit in response to indicator data supplied from an operating unit (i.e., a customer selects musical pieces) and recorded onto the first recording medium (i.e., transferred to video disk).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.


If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax number is (703) 308-1396.

Application/Control Number: 09/319,093

Page 12

Art Unit: 2161

  
Hyung S. Sough  
Primary Examiner  
Art Unit 2161

shs  
August 8, 2001